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10/502,447	03/07/2005	Veronique Ferrari	05725.1370	3679
22852	7590	12/17/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PARK, HAEJIN S	
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			1611	
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			12/17/2010 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/502,447

**Applicant(s)**

FERRARI, VERONIQUE

**Examiner**

H. SARAH PARK

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-37, 40-42, 44-63 and 65-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-37, 40-42, 44-63 and 65-78 is/are rejected.
- 7) ☒ Claim(s) 50, 51 and 67 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date 7/20/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No.(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 20, 2010 has been entered.

### ***Status of Claims***

2. Acknowledgement is made of Applicant's remarks dated July 20, 2010. Claims 35-37, 40-42, 44-63 and 65-78 are the subject of this office action. Claim 64 is cancelled and claims 38-39, 43 and 79-84 are withdrawn. Claims 52-61 are no longer withdrawn.

### ***Information Disclosure Statement***

3. The references listed on the information disclosure statement dated July 20, 2010 were considered and have been made of record to the extent that each was provided in English in full or in an abstract.

### ***Claim Objections***

4. Claims 50 – 51 are objected to because of the following informalities: space within a number, e.g., "1 000 000". Appropriate correction is required.

5. Claim 67 is objected to because of the following informalities: lack of a period indicating the end of the claim sentence. Appropriate correction is required.

***Rejections Withdrawn***

6. The rejection under 35 U.S.C. 103(a) of claims 35 – 37, 40 – 42, 44 – 63 and 65 – 76 and 78 over Tournilhac (EP 1034776 A1 published on September 13, 2000) in view of Stewart (U.S. 5,156,911 issued on October 20, 1992) is withdrawn in light of Applicant's remarks.
7. The rejection under 35 U.S.C. 103(a) of claims 35, 76, and 77 over Tournilhac (EP 1034776 A1, published September 13, 2000) in view of Stewart (U.S. 5,156,911, issued October 20, 1992) and Freund et al. ("Paraffin products: properties, technologies, applications," published 1998) is withdrawn in light of Applicant's remarks.
8. Claims 35 – 37, 40 – 42, 44 – 63 and 65 – 78 stand rejected under new grounds of rejection stated below.

**New Grounds of Rejection**

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. **Claims 35 – 37, 40 – 42, 44 – 63, 65 – 76, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tournilhac (EP 1034776 A1 published on September 13, 2000, English machine translation is relied on for citations) in view of Bitler (WO 01/19333 A1 published on March 22, 2001, #15 on IDS of March 17, 2005) as evidenced by Stewart (U.S. Patent no. 5,156,911 issued on October 20, 1992).**

11. Tournilhac teaches cosmetic compositions comprising olefin polymers which do not migrate over skin surface, present a glossy appearance, resist water, and stays on throughout the day (paras.0007-09).

Concerning claim 35, Tournilhac teaches that the compositions comprise a liquid fatty phase and a semi-crystalline olefin (i.e., crystallinity from 5 to 40%) (para.0010), a coloring matter (para.0014), and a volatile oil such as isododecane (paras.0066-67). Tournilhac further teaches that the olefin copolymer has a melting point lower than 150 degrees Celsius, preferably lower than or equal to 110 degrees Celsius (para.0020) such as those sold under trade name Engage (para.0043). Tournilhac further teaches the use of other homopolymers or copolymers liposoluble or dispersible in the fatty phase such as polybutylene, copolymers of methacrylate and polyisobutylene, perfluorinated homo- or vinylic copolymers of methacrylate, and polyvinylpyrrolidone derivatives or copolymers (paras 0062-63, 0091-92).

Concerning claim 36 – 37 and 40 – 42, Tournilhac teaches isododecane (para.0066). Isododecane has a boiling point at atmospheric pressure of less than 220 degrees Celsius as evidenced by the isododecane MSDS already made of record (see PTO-892 of April 20, 2009).

Concerning claims 44 – 45, Tournilhac teaches use of volatile oils in an amount ranging from 30 to 97.99% of the total weight of the composition (para.0069), overlapping and thus making prima facie obvious the instantly claimed ranges. See MPEP §2144.05.

Concerning claims 46 – 49, Tournilhac does not appear to teach the specific ranges of concentration by reference to the liquid fatty phase or the semi-crystalline polymer. It would however have been *prima facie* obvious to one having ordinary skill in the art at the time of the invention to optimize the ranges of the ingredients of the claims. One would have been motivated to do so dependent upon the desired final properties of the formulation (i.e. skin feel, thickness of composition, etc.) and further motivated by the suggestion of Tournilhac that the amount of oil can be varied from 30 to 97.99 % by weight while still obtaining successful results (para.0069). It has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See MPEP §2144.05.

Concerning claims 50 – 51, Tournilhac teaches that the polymers of the invention have a molecular mass of greater than 30,000 (para.0021), overlapping and thus making *prima facie* obvious the instantly claimed ranges.

Concerning claim 52, Tournilhac teaches the polymers can be solubilized in the fatty phase by heating it to the top of its melting point (para.0037).

Concerning claim 53, Tournilhac teaches olefin copolymers with controlled crystallinity (para.0016) including block copolymers of polyolefins (para.0089).

Concerning claims 56, 57, and 60 – 61, as noted above Tournilhac teaches the use of homopolymers or copolymers of methacrylate and polyisobutylene, perfluorinated homo- or vinylic copolymers of methacrylate, and polyvinylpyrrolidone derivatives or copolymers (paras 0062-63, 0091-92).

Concerning claims 62 – 63, Tournilhac teaches that the polymers are present in an amount ranging from 5% to 70% by weight (para.0036), overlapping and thus making prima facie obvious the instantly claimed ranges.

Concerning claims 65 – 66, Tournilhac teaches that the polymers have a melting point of lower than 150 degrees Celsius, preferably lower than 110 degrees Celsius (para.0020).

Concerning claim 70, Tournilhac teaches use of isononyl isononanoate and polar oils and further that more than one oil may be used (paras.0065-66).

Concerning claims 71 – 72, Tournilhac teaches that the amount of the polymers can be varied from 5 to 70% by weight (para.0036).

Concerning claim 73, Tournilhac teaches that waxes are present in the amount ranging from 0 to 50% by weight (para.0087), overlapping and thus making prima facie obvious the claimed range of "less than 10%." Further, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to include a lower amount of wax motivated by the teaching of Tournilhac that the rate of crystallinity of waxes is not easily controlled and large crystallites may be present when wax is used (para.0004).

Concerning claim 74, Tournilhac teaches that the compositions are preferably anhydrous (para.0094).

Concerning claim 75, Tournilhac teaches that the product can be presented in a cast form (para.0093). Moreover it is noted the casting form is directed to a process for

making the product rather than the product itself and as such does not further define or limit the product structurally.

Concerning claim 76, Tournilhac teaches lipstick, eyeliners, foundations, et cetera (paras.0002, 0093).

Concerning claim 78, Tournilhac teaches a makeup composition comprising a liquid fatty phase having an effective amount of semi-crystalline olefin polymers (crystallinity from 5 to 40%) (para.0010), a pigment (para.0014), where the liquid fatty phase is dispersed in a volatile oil such as isododecane (paras.0066-67). Tournilhac teaches that the polymers have a melting point of lower than 150 degrees Celsius, preferably lower than 110 degrees Celsius (para.0020). Tournilhac further teaches the compositions in the form of a lipstick (paras.0002 and 0093).

12. Tournilhac, while teaching a high melting point polymer (150 degrees Celsius or less), does appear to explicitly disclose use of a semi-crystalline homopolymer or copolymer having a melting point of less than 50 degrees Celsius.

13. Bitler teaches oil-containing compositions comprising polymeric thickeners having side chain crystalline polymers (SCC polymers) (Title; abstract).

Concerning claims 35 and 78, Bitler teaches that the SCC polymers are soluble in oil at temperatures above peak melting temperature  $T_p$  (Title; abstract). The  $T_p$  is preferably not more than 20 degrees Celsius above the temperature of use and Bitler discloses specific examples with  $T_p$ 's of, e.g., 48, 39, and 29 degrees Celsius (p.2 ll.11-



12; p.6 ll.16-18; p.9, Table 1 examples 1, 4, and 6). The SCC polymers specifically include homopolymers and copolymers derived from methacrylic and acrylic monomers and fluorinated methacrylates among others (p.4 ll.10-18; p.5 ll.17-24). The compositions are useful for cosmetics including lipsticks (p.7 ll.23-29).

Concerning claims 50 – 51, Bitler teaches that the SCC polymers have molecular mass ranging from 10,000 to 1,500,000 (p.3 ll.20-23), overlapping and thus making prima facie obvious the instantly claimed ranges.

Concerning claim 52, Bitler teaches that the SCC polymers are soluble in oil at temperatures above peak melting temperature  $T_p$  (Title; abstract).

Concerning claims 54 – 61, Bitler specifies that the SCC polymers “used in the present invention are in themselves are well known” (p.4 l.1) as disclosed in Stewart and the collection of non-patent literature listed at page 4, lines 4 – 9, which are also cited in Stewart (col.6 l.59 – col.7 l.13).

Specifically as to claim 54, Stewart teaches side chain crystallizable polymers where monomer units X have a side chain defined by “S” and “C” where “S” and “C” are named as linear aliphatic side chains of at least 10 carbon atoms (col.5 l.67 – col.6 l.48). It is the position of the examiner that a side chain having a large carbon chain would be hydrophobic.

As to claim 55, Stewart teaches the semi-crystalline polymer having M as a backbone atom, S as a spacer, C as a crystallizable group where S–C can be fluorinated aliphatic chains of at least 6 carbons (col.6 ll.5-48).

As to claims 56 – 61, Stewart teaches that the side-chain crystallizable polymers contain typical monomer “X” and “Y” units comprise acrylic acid, methacrylic acid, C14-C22 acrylates or methacrylates, vinyl ethers or esters, alpha olefins and hydrophilic monomers (col. 6 ll. 5-48; col. 7 ll.29-35). Stewart further teaches monomer “Z” may be included in the polymers, where monomer “Z” may be hydroxyethylacrylate or methacrylamide (col.6 ll.17-29).

Concerning claims 62 – 63 and 71 – 72, Bitler teaches that usually the amount of the SCC polymer can be up to 10% of the total composition (p.6 l.30 – p.7 l.2).

Concerning claim 67, Bitler teaches SCC polymers having melting temperatures ranging from 29 to 48 degrees Celsius (p.9 Table 1, examples 1, 4, 6-8), overlapping and thus making prima facie obvious the instantly claimed range. The Applicant moreover explicitly references Bitler as disclosing the “low-melting polymers” used in the compositions of the instant claims (para.0080)

Concerning claims 75 – 76 and 78, Bitler teaches that the SCC polymers of the invention are particularly useful for cosmetics such as lipsticks (p.7 ll.23-24).

14. It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Tournilhac with the side-chain crystalline polymer thickeners of Bitler including those previously known as evidenced by Stewart. One would have been motivated to do so because Tournilhac teaches the oil-containing cosmetic composition of its invention can beneficially include another semi-crystalline polymer, such as methacrylate homopolymer or copolymer (paras.

0062-63, 0091-92) and Bitler teaches that the SCC polymers (i) usable in two or more SCC polymer combinations (p.3 I.20), (ii) are effective thickeners for oil-containing compositions (p.9 Table 1, examples 1, 2, 4, 6-8), and furthermore (iii) reduce or remove the need to use surfactants which can cause adverse reactions when in contact with human skin (p.2 II.4-9). Consequently one of ordinary skill in the art would have had reasonable expectation of success in obtaining a cosmetic composition that do not migrate over skin surface, present a glossy appearance, resist water, and stays on throughout the day (paras.0007-09), without using skin-irritating surfactants, by combining the oil-containing cosmetic composition of Tournilhac with an additional, SCC polymer of Bitler.

15. Concerning claims 68 – 69 and 71 – 72, neither Tournilhac nor Bitler appears to explicitly disclose the weight ratio of the polymer combination. However, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to optimize the amounts of the polymer combination by routine experimentation. One would have done so under the guidance of Tournilhac and Stewart that the amounts of the polymers can successfully be varied, specifically that the amount of the high-melting semi-crystalline polymer can be varied from 5 to 70% by weight (Tournilhac, para.0036), and that the low-melting polymer can be included up to 10% or more on occasion (Bitler, p.6 I.30 – p.7 I.2). The person of ordinary skill would have done so dependent on the particular cosmetic application and the desired final properties of the formulation such as skin feel, thickness of composition, glossiness, and appearance on skin among others. Where the general conditions of a claim are

disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See MPEP §2144.05.

**16. Claims 35 and 76 – 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tournilhac (EP 1034776 A1 published on September 13, 2000) in view of Bitler (WO 01/19333 A1 published on March 22, 2001) as applied to claims 35 – 37, 40 – 42, 44 – 63, 65 – 76 and 78 above, and in further view of Freund et al. ("Paraffin products: properties, technologies, applications," published 1998).**

The rejection of claims 35 and 76 has been discussed above.

Concerning claim 77, as discussed above Tournilhac teaches a makeup composition comprising a liquid fatty phase having an effective amount of a semi-crystalline olefin copolymer (i.e. crystallinity from 5 to 40%) (para.0010) and a pigment (para.0014), where the liquid fatty phase is dispersed in a volatile oil such as isododecane (para.0066-67). Tournilhac teaches that the copolymers have a melting point lower than 150 degrees Celsius, preferably lower than or equal to 110 degrees Celsius (para.0020). Tournilhac further teaches the use of these copolymers in combination (para.0062-63).

Neither reference appears to explicitly teach the hardness of lipstick.

Freund et al. teaches that the hardness of lipstick can be varied by the inclusion of carnauba or candelilla waxes (p.267).

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Tournilhac and Bitler with the

carnauba and candelilla waxes taught by Freund and achieve a lipstick of the claimed hardness. One would have been motivated to do so in light of the suggestion by Freund that the waxes can be used to obtain lipstick with a certain hardness and the teaching of Tournilhac that both carnauba and candelilla wax can be included in the preparation (para.0085) in varying amounts (para.0087).

### ***Conclusion***

No claim is currently allowable.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. SARAH PARK whose telephone number is 571-270-5258. The examiner can normally be reached on weekdays excluding alternate Fridays, 9 a.m. - 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HSP/  
Examiner, Art Unit 1611

/Sharmila Gollamudi Landau/  
Supervisory Patent Examiner, Art Unit 1611